



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,891	06/17/1999	GUIDO GHISOLFI	32461/GM/1P	5842

7590 11/29/2001

MODIANO & ASSOCIATI
VIA MERAVIGLI 16
MILANO, 20123
ITALY

EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 11/29/2001

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/334,891

Applicant(s)

GHISOLFI, GUIDO

Examiner

Marc A Patterson

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-21.Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached

ADVISORY ACTION

Applicant's arguments filed November 13, 2001 have been fully considered but have not been found to be persuasive.

1. Applicant argues on page 5 of Paper No. 9 that amended Claim 1 overcomes the 35 U.S.C. 103(a) rejection of Claims 1 – 21 as being unpatentable over Martin, Jr. (U.S. Patent No. 4,806,398) in view of Joosten (European Patent No. 0232818), Ochi et al. (Japanese Patent No. 07156980) and The Encyclopedia of Polymer Science and Engineering (Volume 12, page 214, 1985) because the amended claim excludes the presence of a non – recyclable layer. Applicant further argues that the amended claim specifies that the density of the foamed polyester sheet ranges from 100 to 200 kg/m³ whereas the density of the foamed polyester sheet taught by Ochi et al. has a density of 280 – 350 kg/m³. However, the claims prior to amendment did not exclude the presence of a non – recyclable layer, or specify a density from 100 to 200 kg/m³; the amendment therefore raises new issues, which to be completely addressed would require further search and consideration, and the amendment therefore has not been entered. For the same reason, newly submitted Claim 22, dependent on Claim 1, has also not been entered. Even if the amendments were entered, the amended claims would not overcome the rejection because the limitation that the multilayer material ‘be formed by layers having the same chemical nature’ does not exclude the presence of a non – recyclable layer (the phrase ‘same chemical nature,’ in fact, is indefinite) and it would have been obvious for one of ordinary skill in the art to vary the polyester density which is taught by Ochi et al. since density would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end result. *In re Rose 105 USPQ 237 CCPA 1955.*

Normally, it is to be expected that a change in size, amount or thickness would be an unpatenable modification. Under some circumstances, however, changes such as these may impart patentability to an apparatus if the particular size claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant further argues, on page 5, that Joosten fails to disclose a substrate which is a polyethylene terephthalate foam. However, as stated on page 2 of Paper No. 3, Ochi et al. teach a container which is fabricated from polyethylene terephthalate foam, in order to make the container recyclable (Abstract). It would therefore have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to use polyethylene terephthalate rather than paperboard in the invention of Martin Jr. for the purpose of making the container recyclable.

Applicant further argues, on page 6, that the polyester sheet which is taught by Ochi cannot be folded along the lines of a pattern creased on it without breakage. However, folding without breakage is not a claimed aspect of the invention; furthermore, it is unclear what is meant by the phrase 'folded without breakage,' since a pattern which is creased on a sheet is, broadly speaking, a break in the sheet, and folding of the sheet requires expansion of this breakage.

Conclusion


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If

Art Unit: 1772

attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-2364. FAX communications should be sent to (703) 305-3599. FAXs received after 4 P.M. will not be processed until the following business day.

M.A.P.

m.a.p.


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/26/04